REMARKS

Claim Status

Claims 1-5 and 7 are currently pending. Claim 6 was previously cancelled without prejudice or disclaimer of the subject matter thereof.

Claims 1-4 and 7 stand rejected under 35 U.S.C. 102(e) as being anticipated by Sugitani et al. (U.S. Patent No. D514,575) ("D514,575"), and claim 5 stands rejected under 35 U.S.C. 102(e) as being anticipated by D514,575 "as evidenced by" Wang (U.S. Patent No. 6,069,715) ("6,069,715").

Preliminary Comments

As a preliminary matter, Applicants note with appreciation the statement in the Office Action that the rejection under 35 U.S.C. 102(e) might be overcome by a showing under 37 C.F.R. 1.132 that any invention disclosed but not claimed in the reference was derived from an inventor of this application and is thus not the invention "by another." Applicants submit with this Response two Rule 132 Declarations to make this showing and to overcome the rejections of the claims.

Additionally, this Response includes a statement concerning common ownership to disqualify D514,575 as prior art under 35 U.S.C. 103 in the event that the reference is considered as the basis for an obviousness rejection.

Statement Concerning Common Ownership

This application and D514,575 were, at the time the invention was made, owned by, or subject to an obligation of assignment to, PFU Limited. Although the foregoing statement alone is sufficient evidence to disqualify D514,575 from being used in a rejection under 35 U.S.C. 103(a) against the claims of this application (MPEP 706.02(l)(2)), Applicants additionally note that records of the PTO indicate that (1) this application is assigned to PFU Limited by an

assignment recorded at Reel/Frame 017779/0677, and (2) D514,575 is assigned to PFU Limited by an assignment recorded at Reel/Frame 014697/0207.

For these reasons, D514,575 would not qualify as prior art under 35 U.S.C. 103.

Rule 132 Declarations

With this Response, Applicants submit two Rule 132 Declarations. They establish that any of Applicants' invention disclosed in D514,575 was derived from Applicants, is Applicants' own work, and is thus not the invention "by another."

As stated in MPEP 2136.05, a 35 U.S.C. 102(e) rejection can be overcome by showing the reference is describing an applicant's own work:

> [W]hen the unclaimed subject matter of a reference is applicant's own invention, applicant may overcome a *prima facie* case based on the patent ... by showing that the disclosure is a description of applicant's own previous work. Such a showing can be made by proving that the patentee ... was associated with applicant ... and learned of applicant's invention from applicant. MPEP 2136.05 (citing *In re* Mathews, 161 USPQ 276 (CCPA 1969)).

See also MPEP 715.01(c)(II) ("When the unclaimed subject matter of a patent ... is applicant's own invention, a rejection ... on that patent ... may be removed by submission of evidence establishing the fact that the patentee ... derived his or her knowledge of the relevant subject matter from applicant."); MPEP 716.10 (Example 2 states that "an affidavit under 37 CFR 1.132 may be submitted to show that the relevant portions of the reference originated with or were obtained from applicant."); and *In re* Facius, 161 USPQ 294 ("If [the applicant] *invented* the subject matter upon which the relevant disclosure in the patent was based, then the patent may *not* be used as a reference against him ... .") (emphasis in original).

Unlike a Rule 131 Declaration, a Rule 132 Declaration need not prove diligence or reduction to practice -- a showing that the reference disclosure arose from an applicant's work coupled with a showing of conception by the applicant before the filing date of the reference is sufficient:

> When the reference reflects applicant's own work, applicant need not prove diligence or reduction to practice to establish that he or she invented the subject matter disclosed in the reference. A showing that the reference disclosure arose from applicant's work coupled with a showing of conception by the applicant before the filing date of the reference will overcome the 35 U.S.C. 102(e) rejection. The showing can be made by submission of an affidavit by the inventor under 35 CFR. 1.132. MPEP 2136.05

As set forth below, the Rule 132 Declarations submitted with this Response establish that, to the extent that Applicants' invention is disclosed in D514,575, that disclosure was of Applicants' own work, was derived from Applicants, and is thus not the invention "by another."

D514,575

D514,575 discloses and claims the ornamental design for an image reader for a computer, as shown and described in that patent. Specifically, the ornamental design for the image reader for a computer is shown in Figures 1-11.

In rejecting claims 1-5 and 7, the Office Action refers to particular figures of D514,575 and also alleges that particular features are inherently disclosed in D514,575. Specifically, the Office Action refers to the following figures:

1) Figures 1-4 of D514,575 are cited in connection with claim 1,
2) Figures 2 and 3 of D514,575 are cited in connection with claim 2,
3) Figures 3 and 4 of D514,575 are cited in connection with claim 3,
4) Figures 4 and 5 of D514,575 are cited in connection with claim 4, and
5) Figures 1-4 of D514,575 are cited in connection with claim 7.

The Office Action also refers to features that are allegedly inherent in D514,575:

1) In connection with claims 1 and 7, the Office Action states that " 'the relative position and relative orientation of ADF in related to the flat bed mechanism can be changed' inherently with the support of a movable couple mechanism."
2) In connection with claim 3, the Office Action states that "FIG 4 illustrates the ADF rotating 180 degree inherently by means of a pivot or rotating post mechanism supported by the rails."
3) In connection with claim 5, the Office Action states that "using protrusions or posts to plug in holes at a plurality of positions or similar holding mechanism to secure the ADF at a selected position is implicit in the Sugitami [sic] design." With reliance on the Wang reference, the Office Action also states that "the same application inherently can be repeated as required to locate the ADF at different positions on the flat bed mechanism."

Accordingly, the Office Action relies on particular subject matter allegedly disclosed in Figures 1-5 of D514,575 and particular features that are alleged to be inherent in the disclosure of D514,575.

Applicants neither acquiesce nor agree to the characterizations in the Office Action of what is disclosed, explicitly or inherently, in D514,575. Nevertheless, D514,575 does not qualify as a reference because, to the extent that Applicants' invention is disclosed in D514,575, that disclosure was of Applicants' own work, was derived from Applicants, and is thus not the invention "by another."

The Rule 132 Declaration of Mr. Masayoshi Kawai ("Kawai Declaration") submitted with this Response establishes at least the following:

1. To the extent that the invention conceived by Applicants is described in D514,575, their invention was made prior to the U.S. Filing Date of D514,575, and was thereafter described in D514,575 by the inventors of D514,575. **[Kawai Declaration ¶ 4]**

2. A Request Paper referred to in the Kawai Declaration illustrates and describes features of an image scanner apparatus, including embodiments of a scanner apparatus shown and described in the Request Paper (Exhibit 1) at, for example, Pages 2/5 and 4/5 and elsewhere. **[Kawai Declaration ¶ 6]**

3. The invention illustrated and described in the Request Paper was conceived before the U.S. Filing Date of D514,575 and was explained to inventors of D514,575. **[Kawai Declaration ¶¶ 7 and 8]**

4. The inventors of the ornamental design claimed in D514,575 made no inventive contribution to the functional features claimed in this utility patent application. **[Kawai Declaration ¶ 9]**

5. To the extent that the invention claimed in this application is described in D514,575, the relevant subject matter of D514,575 describes Applicants' work, was derived from Applicants, and is not an invention "by another." **[Kawai Declaration ¶ 10]**

Additionally, the Rule 132 Declaration of Mr. Takeshi Chujou ("Chujou Declaration") submitted with this Response establishes at least the following:

1. Applicants' invention was explained by two of the inventors of D514,575 to the remaining inventors of D514,575. **[Chujou Declaration ¶ 8]**

2. The inventors of the ornamental design claimed in D514,575 made no inventive contribution to the functional features claimed in this utility patent application. **[Chujou Declaration ¶ 9]**

3. To the extent that the Applicants' invention is described in D514,575, the relevant subject matter of D514,575 describes the Applicants' work, was derived from the Applicants, and is not an invention "by another." **[Chujou Declaration ¶ 10]**

For these reasons, the Declarations submitted with this Response establish that, to the extent that Applicants' invention is disclosed in D514,575, that disclosure was of Applicants' own work, was derived from Applicants, and is thus not the invention "by another." Therefore, the rejections of claims 1-5 and 7 based on D514,575 should be withdrawn.

CONCLUSION

For the foregoing reasons, and in view of the evidence submitted with this Response in the Kawai Declaration and the Chujou Declaration, it is respectfully submitted that all of the claim rejections should be withdrawn. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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